

hereinafter Hvizd); Claims 20 and 21 were rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd, and further in view of Eton et al. (U.S. Patent No. 5,066,881, hereinafter Elton); Claim 26 was rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd, and further in view of Silver et al. (U.S. Patent No. 4,384,944, hereinafter Silver); Claim 27 was rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd and Silver, and further in view of Robert et al. (U.S. Patent No. 5,530,206, hereinafter Robert); Claim 28 was rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd, and further in view of Yamanouchi et al. (U.S. Patent No. 4,894,284, hereinafter Yamanouchi); Claim 29 was rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd and Silver, and further in view of Yamanouchi; Claim 34 was rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd, and further in view of Breitenbach et al. (U.S. Patent No. 4,785,138, hereinafter Breitenbach); and Claim 35 was rejected under 35 U.S.C §103(a) as being unpatentable over Carini in view of Hvizd, and further in view of Simmons et al. (U.S. Patent No. 4,997,995, hereinafter Simmons).

In the Amendment filed October 24, 2001, Claim 38 was amended in response to a rejection under 35 U.S.C. §102(b) as being anticipated by Carini. The amendment filed October 24, 2001 also included arguments presented to overcome the various claim rejections under 35 U.S.C. 103(a) as being unpatentable over Carini in view of Hvizd, and in some cases various tertiary references. These arguments included references to and incorporated by reference arguments presented in Amendments filed September 14, 2000, and January 20, 2000 that had not been considered in the earlier Office Actions. Since again, those arguments have not been addressed by the Examiner, the arguments

presented in the Amendments filed October 24, 2001, September 14, 2000, January 20, 2000 are incorporated herein by reference.

In the outstanding Office Action, Claim 38 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Carini in view of Hvizd. It is respectfully submitted that for reasons similar to those presented in the earlier filed Amendments, that neither Carini nor Hvizd teach or suggest a second equipotential surface of an insulated conductor having a resistivity within the particular critical range of 10 through 500 ohm\*cm required by Claim 38. Consequently, it is respectfully submitted that no matter how Carini and Hvizd are combined, the combination fails to teach or suggest the invention defined by Claim 38.

In the Response to Arguments section of the outstanding Office Action, the Examiner has asserted that "Applicant's arguments with respect to claim 38 have been considered but are moot in view of the new ground(s) of rejection except for the following."<sup>1</sup> The Office Action then asserts that

... Hvizd, Jr. et al. discloses a range (1 to 1,000,000 ohm\*cm) including the claimed range (10 to 500 ohm\*cm). Accordingly, the combination of Carini et al. and Hvizd, Jr. et al. teaches the claimed invention and would achieves [sic] unexpectedly good results.<sup>2</sup>

The outstanding Office Action, like the Office Action dated April 24, 2001, provides no response to the arguments presented regarding the asserted teachings of and Hvizd. As stated in the MPEP:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. . . .

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<sup>1</sup> See Office Action dated November 30, 2001, at numbered paragraph 10, p. 8.

<sup>2</sup> *Id.*

If it is the examiner's considered opinion that the asserted advantages are not sufficient to overcome the rejection(s) of record, he or she should state the reasons for his or her position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner . . .<sup>3</sup>

In an Examiner Note regarding the use of form paragraph 7.38 to indicate an applicant's arguments are moot because of new ground(s) of rejection, the MPEP stresses that "[t]he examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied."<sup>4</sup>

It is respectfully submitted that Applicants' arguments regarding the proposed combination of Carini (and other cable references asserted in previous Office Actions) and Hvizd have not been addressed. Applicants respectfully request consideration of the arguments presented in this regard.

As discussed above, the outstanding Office Action asserts that the proposed combination of Carini and Hvizd would achieve "unexpectedly good results." However, this assertion has not been supported with any evidence.

In the recent CAFC decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002), the court stressed the requirement for basing obviousness rejections on evidence, and not on conclusory statements made by an Examiner to support a rejection:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.<sup>5</sup>

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<sup>3</sup> See MPEP at §707.07(f).

<sup>4</sup> *Id.*

<sup>5</sup> *In re Lee*, 61 USPQ2d 1430, 1433 (CAFC 2002).

...In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the Examiner and the Board are presumed to act from [the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains"]. Thus, when they rely on what they assert to be general knowledge to negate patentability, the knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.<sup>6</sup>

It is respectfully submitted that the rejections set forth in the outstanding Office Action are based on conclusory statements, and not based on evidence as is required to be consistent with the guidance set forth in *In re Lee*.

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<sup>6</sup> *Id.* at 1435

Consequently, in light of the above comments, it is respectfully submitted that the inventions defined by Claims 19-38, as amended, are patentably distinguishing over the prior art. The application is therefore believed to be in condition for formal allowance, and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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